



PATENT
P56905

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

YOSHITAKA TERAO *et al.*

Serial No.: 10/629,793 Examiner: WILLIAMS, JOSEPH L.

Filed: 30 July 2003 Art Unit: 2879

For: PLASMA DISPLAY PANEL AND MANUFACTURING METHOD THEREOF
WHERE ADDRESS ELECTRODES ARE FORMED BY DEPOSITING A LIQUID
IN CONCAVE GROOVES ARRANGED IN A SUBSTRATE (*as amended*)

PETITION UNDER 37 CFR §1.144

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant respectfully petitions from a finality of a restriction requirement of Paper No. 20050404 mailed on 8 April 2005 and finalized on Paper No. 20061126 mailed 11 December 2006.

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Date: 1/26/07
I.D.: REB/ML/fw

STATEMENT OF FACTS

1. On 8 April 2005, a Restriction Requirement (Paper No. 20050404) was mailed restricting method claims 5-9 and 15-19 from apparatus claims 1-4 and 10-14;
2. On 9 May 2005, Applicant filed a Amendment & Response under 37 C.F.R. 1.143 provisionally electing apparatus claims covered by claims 1-4 and 10-14, adding linking claims 20 and 21 while canceling claim 14 and traversing the restriction requirement of Paper No. 20050404 as per 37 C.F.R. 1.143; and
3. On 11 December 2006, an Office action on the merits was mailed (Paper No. 20061126) examining only apparatus claims 1-4, 10-13 and 21 drawn to the elected group. In Paper No. 20061126, the Examiner acknowledged Applicant's 9 May 2005 37 C.F.R. 1.143 traversal but finalized the 8 April 2005 Restriction Requirement.

REMARKS

In Paper No. (20061126) mailed December 11, 2006, the Examiner finalized the following restriction requirement of Paper No. 20050404:

Group I, claims 1-4 and 10-14 drawn to a plasma display panel, classified in class 313, subclass 582; and

Group II, claims 5-9 and 15-19, drawn to a method of manufacturing the plasma display panel, classified in class 445, subclass 24.

Applicant submits that this Restriction Requirement is improper for the following three reasons:

1. In Paper No. (20050404), the Examiner justifies the restriction requirement under MPEP 806.05 (f) by saying that Applicant's apparatus of the plasma display panel can be made by another and materially different process. Specifically, the Examiner states that in Paper No. (20050404), "In the instant case as opposed to heating the substrate after the conductive liquid is applied, the substrate could be heated prior to supplying the conductive liquid material." Applicant disagrees.

Applicant submits that if the substrate is heated prior to supplying the conductive liquid, Applicant's claimed structure would not result. This is because the heating serves to bond together the precipitated material into a solid electrode structure. If heat is applied before the conductive

liquid is applied, and before the precipitate is allowed to settle to the bottom of the concave sections, the electrodes can not form.

In Applicant's invention, the liquid is applied to the concave grooves. Then time elapses so that precipitate is allowed to precipitate out of the solution and form on the bottom. Then, the substrate is heated so that the precipitate can bond together to form the electrode.

If the wafer is heated prior to application of the liquid as proposed by the Examiner, the wafer will cool down long before the precipitate is allowed to fall out of the solution and collect at the bottom of the concave portions. And since the heat is never applied after the precipitate has already precipitated out of the solution, the electrodes can not form under the Examiner's proposed method.

The liquid must first be applied and then the conductive particles and the glass frit need to given an opportunity (i.e., time) to precipitate to the bottom of the concave portions before heat is applied in order to form the claimed electrode structure. This claimed electrode structure would not result if the heat is applied prior to the application of the solution. Therefore, Applicant submits that Applicant's claimed plasma display panel would not result if heat is applied prior to the supplying of the conductive liquid. As a result, Applicant submits that Applicant's novel plasma display panel cannot be made by a materially different process. As a result, Applicant submits that the Restriction Requirement of Paper No. 20050404 is without merit.

2. In Paper No. 20050404, the Examiner indicated a different classification for Applicant's method claims than for Applicant's apparatus claims. The Examiner in Paper No. 20050404 then used the alleged separate classification as justification for the restriction requirement of Paper No. 20050404. Applicant objects for the following reasons.

Applicant submits that the classes and subclasses cited by the Examiner for the apparatus claims are not classified according to method and apparatus. Class 313, subclass 582, which the Examiner states is the classification for Applicant's *apparatus* claims, pertains to both structural patents and method of making patents. Applicant has looked at the patents in this class and subclass and has found, for example, that U.S. Patents 6,800,010, 6,777,872 and 6,860,781 which contain only method of making claims and do not contain any apparatus claims. In addition, US Patents 6,876,150, 6870315, 6870314, 6855196, 6833672 and 6833086 are all found in class 313, subclass 582, but all of these patents contain *both* Apparatus and Method of making claims. Applicant submits that because patents are presumed valid, that the prior art search on the part of the Examiner for Applicant's method claims is *coextensive* with the search for Applicant's apparatus claims. Because the search is coextensive, Applicant submits that there is no undue burden on the part of the Examiner to examine both Applicant's apparatus and Applicant's method claims in a single examination. And because there is no undue burden, Applicant submits that the Restriction Requirement of Paper No. 20050404 is without merit.

3. Applicant further traverses the above restriction requirement for the reason that

Applicant's apparatus claims and Applicant's method claims are drawn to the same embodiment. This is important because it is a well known tenet of U.S. patent law that claims drawn to a single embodiment may not be restricted from each other. See MPEP 806.03. Since the Examiner is attempting to divide Applicant's claims drawn to the same embodiment, the Restriction Requirement of Paper No. 20050404 is improper and must be withdrawn.

RELIEF REQUESTED

Accordingly, the Commissioner is respectfully requested to:

- A. Require the withdrawal of the Restriction Requirement of Paper No. 20050404;
- B. Examine all of Applicant's claims on the merits in a single examination without further undue process;
- C. Require that said single examination be made non-final; and
- D. Grant such other and further relief as justice may require.

Respectfully submitted,



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